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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/912,575	07/26/2001	Sung-Ho Kang	P56410	5495
8439 7590 10/30/2009 ROBERT E. BUSHNELL & LAW FIRM 2029 K STREET NW SUITE 600 WASHINGTON, DC 20006-1004			EXAMINER PHILLIPS, HASSAN A	
			ART UNIT 2451	PAPER NUMBER
			MAIL DATE 10/30/2009	DELIVERY MODE PAPER

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RECORD OF ORAL HEARING

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SUNG-HO KANG

Appeal 2009-005972
Application 09/912,575
Technology Center 2400

Oral Hearing Held: October 8, 2009

Before KENNETH W. HAIRSTON, MARC S. HOFF, and THOMAS S. HAHN, *Administrative Patent Judges*.

ON BEHALF OF THE APPELLANT:

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The above-entitled matter came on for hearing on Thursday, October 8, 2009, commencing at 9:0 a.m., at The U.S. Patent and Trademark Office, 600 Dulany Street, Alexandria, Virginia, before Victor Lindsay, Notary Public.

PROCEEDINGS

THE USHER: Calendar No. 26, Mr. Bushnell.

MR. BUSHNELL: You have my card, right? Do you owe me any transcripts or are we up-to-date?

COURT REPORTER: I'm sorry?

MR. BUSHNELL: Do you owe me any transcripts or are we up-to-date?

COURT REPORTER: I think we're good.

MR. BUSHNELL: Okay.

JUDGE HAIRSTON: Counsel, before we begin, we have visitors from the European Patent Office and they're going to listen in today.

MR. BUSHNELL: Which offices in Europe?

JUDGE HAIRSTON: The EPO itself.

MR. BUSHNELL: Oh, the EPO? And you're explaining to them that they've been butchering our -- and irritating our inventors and -- and it's something very -- 112-type clients from the Europeans?

JUDGE HAIRSTON: Well, that's beside the point.

MR. BUSHNELL: Well, when we come over there and argue those EPO claims, we get a lot of complaints --

JUDGE HAIRSTON: Well, counsel, before we begin, we agree with you that the "What is DHCP" publication does not have a good enough date to be applied against you, so we can skip arguments about that today, okay?

MR. BUSHNELL: Thank you, Your Honors. Actually, it's not part of the administrative -- listen to me -- it's part of the administrative record --

JUDGE HAIRSTON: Well, -- the Examiner cited --

MR. BUSHNELL: -- it's not been applied --

1 JUDGE HAIRSTON: -- as background, he cited it as background and
2 you're right, your argument in the Brief is correct, it's not a good enough
3 date to be discussed here today.

4 MR. BUSHNELL: Okay, very good. If it please the Board, I'm
5 Robert E. Bushnell. I'm representing -- oh, this is Samsung Electronics Co.,
6 LTD. What we've got here is a network system and they recognized at least
7 two problems in the prior art. One of those problems is to avoid the expense
8 of the -- incurred by using a fixed IP address, the Applicant prefers to use
9 the lower cost, the variable IP address. A second problem is regardless of
10 which IP address you have in a reference -- Anderson recognizes this second
11 problem. And I think in column 9 regardless of which type IP address when
12 you're constantly changing your IP address, particularly with the examples
13 used here where the device is portable like a video camera, you unplug it
14 from the computer and you go outside and photograph leaves and pretty
15 women or whatever you do, and you come back and plug it in, you've got to
16 get a new IP address. And if your mother-in-law in a remote location wants
17 to access your memory to see what pictures you've been taking, she doesn't
18 know which IP address regardless whether it's fixed or variable.

19 Now the reference recognized that there was a problem with the cost
20 of the IP address and it does add up. You try to minimize the number of IP
21 addresses you have by using a router or a hub inside your office. These are
22 things you have to know. When you retire here and go out and practice,
23 you've got to buy a router, or at least a hub, for your office; otherwise,
24 Verizon or whoever is going to sock it to you pretty heavily the first month.
25 So what the Applicant does is come up with a scheme addressing both -- or a
26 circuit for addressing both problems being able to, as they say, on the top of

1 page 4, paragraph 9 wherein variable IP addresses of network units --
2 network unit would be the video camera -- or recognizes fixed IP addresses.
3 And they discuss the cost and all that on page -- I think it's -- okay, where I
4 just read is part of the summary invention. We don't need to get into the
5 alleged admission of prior art and that sort of thing. Even if we would argue
6 arguendo, the admission of prior art is prior art, the fact is the Examiner is
7 misinterpreting what's written on pages 1, 2, and 3. It's the Applicant who
8 recognized these problems.

9 JUDGE HAIRSTON: But DHCP servers were known to issue
10 variable IP addresses long before your client, right?

11 MR. BUSHNELL: That's a good question. They weren't using them
12 for the same purpose, and I think they were invariably issuing fixed IP
13 addresses.

14 JUDGE HAIRSTON: But the other two publications cited by the
15 Examiner have dates that predate your Client's filing date, and they say that
16 variable IP addresses were known to be issued by a DHCP server.

17 MR. BUSHNELL: Oh, yeah, variable IP addresses and fixed IP
18 addresses were known.

19 JUDGE HAIRSTON: Okay.

20 MR. BUSHNELL: What the telephone company will ask you in
21 passing when they're wiring up your office -- a dynamic or static system.
22 That's a key word for how much do you want to pay.

23 JUDGE HAIRSTON: Yeah, Anderson is dial-up service, so, yeah,
24 that's dynamic IP.

25 MR. BUSHNELL: Right, right. So what you're -- what you want to
26 do is resolve those or overcome those two problems. One technique that the

1 Applicant disclosed, and it's in each of the claims, is that they have multiple
2 ways of identifying the user -- the unit -- the network unit, that is. One of
3 them, for example, they can use all or part of the Ethernet address. The
4 Ethernet address comes off of the local area network card, and we wire up
5 your office, you can do that part yourself. You want to have at least one
6 local area network connecting all your equipment. It's not wise, however, to
7 put your online equipment on there so you won't be invaded. Now, what the
8 Applicant does is they can also use a search word in lieu of the part of the
9 Ethernet. Anderson attempts to assign a unit number or something of that
10 nature for his user name. And he has --

11 JUDGE HAIRSTON: Isn't that broadly a key word, search key word?

12 MR. BUSHNELL: Well, that gets into the question of what a key --

13 JUDGE HAIRSTON: It could be anything, broadly speaking, it could
14 be anything.

15 MR. BUSHNELL: Probably it couldn't be anything, it couldn't be
16 the -- you wouldn't want it to be the Ethernet address, but it would be a
17 number that's assigned to the unit. Often you see the video units on the
18 street in Washington, they have like Camera 1, Camera 2, and that's what
19 you would use. What the Applicant's done now is define these techniques in
20 the form of its dynamic host configuration protocol server which Anderson,
21 for whatever reason, doesn't recognize would be needed to give him his
22 variable address whenever the user network unit requests that. He just --
23 he's oblivious to that and instead is using dial-up and he's getting whatever
24 the IP provider gives him as his IP address. By using this -- and I'm not
25 asserting that anything here, any of these units, are new in themselves, but
26 by combining the dynamic host configuration server with a network unit,

1 every time you take a camera out or every time you power it up, as
2 explained in the Spec, you get your variable IP address and the network unit
3 communicates that to the agent server along with its ID. And intrinsically if
4 it's used in a local area network card, which it sounds like it must with all or
5 part of the Ethernet address, and then your mother-in-law using her
6 computer 95 can dial you up just by knowing your -- whatever your camera
7 1 or whatever, that's shown in Figure 5.

8 So the advantage over the Examiner's proposed combination,
9 assuming his combination is valid that the Applicant's background
10 discussion and recognizing a problem in the art is prior art rather than
11 Applicant's own work, assuming that combination, arguendo is valid.
12 What's missing there is the ability of Anderson to use the lower cost variable
13 Internet address.

14 JUDGE HAIRSTON: But it uses a variable Internet address in that
15 the dial-up assigns him a variable IP address.

16 MR. BUSHNELL: Not when you're using Applicant's circuit by
17 augmenting it with a dynamic host configuration protocol server.

18 JUDGE HAIRSTON: Well, yeah, Anderson does not use a DHCP.

19 MR. BUSHNELL: That's because he doesn't recognize the problem
20 of the cost between the fixed and variable IP address.

21 JUDGE HAIRSTON: Well, he doesn't have to recognize the problem,
22 but he, he actually uses a variable IP address. He may not use a DHCP
23 server --

24 MR. BUSHNELL: I don't think he uses the adjective variable
25 anywhere.

26 JUDGE HAIRSTON: I'm sorry --

1 MR. BUSHNELL: Anderson.

2 JUDGE HAIRSTON: Dial-up by its very nature is variable, it
3 changes.

4 MR. BUSHNELL: No, no, no, the IP address is assigned not by you,
5 but by the telephone company or your IP provider.

6 JUDGE HAIRSTON: But that -- but the dial-up service is a variable
7 IP address by its very nature.

8 MR. BUSHNELL: Well, it's variable from instant to instant, but if
9 we're talking about something other than a video camera, for example if
10 we're talking about a fixed video camera that's never unplugged, you're
11 going to have the same IP address. If we're talking about the unit 95, the
12 user laptop or whatever that is, it's going to have the same IP address until
13 hell freezes over. It's never going to change.

14 JUDGE HAIRSTON: Well, we're not talking about the user's IP
15 address, we're talking about the, the Internet -- the server, video server's IP
16 address -- 50, that's variable.

17 MR. BUSHNELL: Yeah, that's a network. It's only variable in that
18 you're getting a different fixed IP address every time you dial up.

19 JUDGE HAIRSTON: Right.

20 MR. BUSHNELL: Right.

21 JUDGE HAIRSTON: With Anderson.

22 MR. BUSHNELL: But it's actually a fixed IP address which when
23 you add the dynamic host configuration protocol server --

24 JUDGE HAIRSTON: Well, where do you argue that in your Brief?

25 MR. BUSHNELL: He actually did. You want me to do that now?

26 JUDGE HAIRSTON: Yes, please.

1 MR. BUSHNELL: Okay. Oh, that's right in the Specification. Okay.
2 In paragraph 5 of the original Specification, such IP addresses and networks
3 may be generally classified into two types: fixed IP address and variable IP
4 address.

5 JUDGE HAIRSTON: No, I'm talking about your Brief, your
6 argument concerning Anderson.

7 MR. BUSHNELL: Okay. Okay, alludes to the -- paragraph on the
8 bottom of 2, top of page 3 of the Reply Brief where the Examiner is saying
9 there's no mention of solving the unknown address problem -- invention.
10 What the Examiner's doing is using shorthand to characterize the substance
11 of the Claim, which does solve the problem of unknown address. And then
12 each time -- on the third argument in the Reply Brief, full paragraph on page
13 3 and ending about on page 10, line 8 of the Examiner's Answer, Examiner
14 states as previously indicated, Anderson suggests the IP -- or ISP 710
15 utilizing a DHCP server to assign addresses to a network each time the
16 network unit establishes an Internet connection. Okay. Okay, then is
17 controlled -- Appeal Brief now. I'm going to the second Appeal Brief here.
18 Okay, beginning with page 13, the bottom paragraph carrying over to page
19 14, intrinsic in the absence of any DHCP server in Anderson is the absence
20 of any assignment of variable protocol address for a predetermined period of
21 time. And then -- okay.

22 JUDGE HAIRSTON: See in Anderson, when you dial up, you're
23 connected to the provider for a predetermined period of time, so, right, isn't
24 that a variable address -- IP --

25 MR. BUSHNELL: No, it's not a predetermined period of time. It's an
26 indefinite period of time, and it's whatever number you get from your

1 Internet service provider which is not going to be a variable. The DHCP has
2 a list or a bank of interchangeable variable IP addresses. It doesn't have to
3 do a dial-up to get you an IP address. And by using that bank, that intrinsic
4 bank, you've cut your cost right there because the telephone company has no
5 knowledge of what IP address you're using. You're assigned locally by your
6 DHCP from one of those addresses. Your mother-in-law on her computer
7 95 just doesn't know which one was assigned to you. That's why the
8 presence of the DHCP is important, it's local equipment, something you buy
9 yourself as opposed to rent each time you dial up to the telephone company.

10 Okay.

11 You know what, what I'm -- don't see in the -- in the context -- or in
12 the text of the Appeal Brief is a quotation from pages 2 and 3 of the original
13 Specification explaining why you want to use a variable as opposed to a
14 fixed IP address.

15 JUDGE HAIRSTON: Does your Brief talk about that predetermined
16 period of time as distinguished from Anderson?

17 MR. BUSHNELL: In the Brief or the Specification?

18 JUDGE HAIRSTON: In your Brief, do you distinguish over
19 Anderson by arguing that predetermined period of time in your Brief?

20 MR. BUSHNELL: That's a good question.

21 JUDGE HAIRSTON: Anderson has a period of time obviously.

22 MR. BUSHNELL: Yeah, right. And what you don't have with the
23 DHCP is a fixed period of time. You have a period of time, but it hasn't
24 been determined when you assign it --

25 JUDGE HAIRSTON: You mean dial-up? You mean dial-up?

1 MR. BUSHNELL: When you dial up, you're getting whatever the, the
2 Internet portal assigns to you. That's -- it could be fixed forever if you don't
3 unplug your equipment.

4 JUDGE HAIRSTON: Right, there's a period of time as long as you
5 don't hang up, right, exactly.

6 MR. BUSHNELL: Well, you can hang up, but -- you have that, I
7 mean you do turn off the computer from time to time, but what the IP
8 address is is both your address and it's identification for the equipment.

9 JUDGE HAIRSTON: Right.

10 MR. BUSHNELL: So, your mother-in-law can use that IP address if
11 she knows it and she doesn't have to worry about our invention or
12 Anderson's invention, but invariably they don't. I mean how many people
13 walk around memorizing all their friends' IP addresses? So that, that's -- but
14 the main difference here is what exactly -- what's set forth in the original
15 Specification. Anderson doesn't recognize that problem and I don't know
16 why. It, it's just not something that he alludes to even though you could
17 buy -- or install DHCP at the time our application was filed. So I mean just
18 as you could have used a charred piece of bamboo for the filament instead of
19 twisted silk in Edison's light bulb at the time Edison made his light bulb, I
20 don't think anyone's shouting that his light bulb using the charred bamboo is
21 obvious. So what they have here is somebody that -- with the ingenuity to
22 use the DHCP, existing or not, and I submit it was existing, in this particular
23 application. And then if you put a pencil beside these claims, they're not
24 claiming the entire Internet. They're claiming this specific apparatus, and
25 we focus not so much on the problems in the art in writing this claim, the
26 Examiner noted that we didn't say we're solving the unknown IP address

1 problem with this Claim. Well, no, we don't put the advantages provided by
2 the invention in the Claim. Nobody writes claims like that. I don't even
3 think they do that in the EPO, but what we've got here is a structure that
4 provides you the advantage and that's what was argued in the Briefs, the
5 structure. Thank you, gentlemen.

6 JUDGE HAIRSTON: Any questions?

7 JUDGE HAHN: No questions.

8 JUDGE HAIRSTON: Thank you, counselor.

9 MR. BUSHNELL: Are you going to let these visitors get out of here
10 without --

11 (Whereupon, the proceedings, at 10:49 a.m., were concluded.)